

Attorney Docket No. P11119

**REMARKS/ARGUMENTS****1.) Claim Amendments**

Claims 1-2, 7-12 have been amended.

Claims 3-6, 13-36 have been canceled.

Claims 37-50 have been added.

Accordingly, claims 1-2, 7-12, and 37-50 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

**2.) Claim Rejections – 35 U.S.C. § 102(e)**

The Examiner rejected claims 1, 2, 4-7, 10, 13-17, 19-26, 31 and 32 under 35 U.S.C. § 102(e) as being anticipated by Krishman (US 5,924,026). The Applicants have amended the claims to better distinguish the claimed invention from Krishman. It is respectfully submitted that the claims, as amended, are not anticipated by Krishman. For instance, amended claim 1 states:

1. A method of negotiating operating capabilities in a telecommunications system including at least one mobile station, the method comprising:  
receiving a first list of operating capabilities for a mobile station at a first node upstream of and associated with the mobile station wherein the list is received prior to setting up a call with the mobile station,  
storing the operating capabilities at the first node,  
receiving a second list of operating capabilities from a second node, when the second node is attempting to set up a call with the mobile station,  
comparing the second list to the first list to negotiate agreed-upon operating capabilities between the second node and the mobile station.

Krishman does not teach the elements underlined above. Specifically, Krishman does not teach: (1) receiving a first list of operating capabilities wherein the list is received prior to setting up a call with the mobile station, (2) receiving a second list of operating capabilities from a second node when the second node (which is not the mobile station) is attempting to set up a call with the mobile station, and (3) comparing

Attorney Docket No. P11119

the second list to the first list to negotiate agreed-upon operating capabilities. Thus, several of the limitations recited in claim 1 are not taught or suggested by Krishman. The Applicants note that basis for these amendments are found in the original specification on page 8, which describes in detail the elements of the claim. Therefore, the withdrawal of the rejection under § 102 and the allowance of claim 1 are respectfully requested.

Claims 2, 7-12 depend from claim 1 and recite further limitations in combination with the novel elements of claim 1. Therefore, the allowance of claims 2, 7-12 is also respectfully requested.

New claims 37 and 44 recite the novel elements of: receiving data indicating the device operating capabilities associated with the first mobile station, wherein the data is communicated without establishing a call connection between the first mobile station and the first switch node; storing the communicated data within the storage means; receiving a call setup message from the first mobile station to establish an outgoing call connection towards the second mobile station; retrieving the stored data within the storage means; and including the retrieved data within the outgoing call setup message to allow the data to be reviewed by a second switch node serving the second mobile station for device compatibility. These claim elements are not taught by Krishman. Thus, these claims and their dependent claims are also in a condition for allowance.

### 3.) Claim Rejections – 35 U.S.C. § 103 (a)

The Examiner rejected claims 3, 11, 12, 18 and 33-36 under 35 U.S.C. § 103(a) as being unpatentable over Krishman (US 5,924,026). The Applicants have canceled claims 3, 18, and 33-36 and have amended claim 11-12 to better distinguish the claimed invention from Krishman. As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." The combination of Krishman and the Examiner's use of official notice do not contain all of the claim elements for the amended claims.

Attorney Docket No. P11119

The Examiner rejected claims 8, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Krishman (US 5,924,026) in view of Laiho (US 6,522,655). The Applicants have canceled claims 27 and 28 thereby rendering the rejection moot. Claim 8 is allowable because it depends on amended claim 1. As explained above, claim 1 contains claimed elements not found in either Krishman nor Laiho.

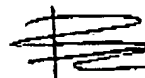
The Examiner rejected claims 9, 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Krishman (US 5,924,026) in view of Cooper (US 6,321,079). The Applicants have canceled claims 29 and 30 thereby rendering the rejection moot. Claim 9 is allowable because it depends on amended claim 1. As explained above, claim 1 contains claimed elements not found in either Krishman nor Cooper.

### CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-2, 7-12 and 37-50.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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Amendment - PAGE 9 of 9  
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